

REMARKS

This communication responds to the *Office Action* dated October 15, 2009. Applicants have amended claims 1, 7, and 25. Claims 13-17 were previously canceled and no claims are either presently canceled or added. Consequently, claims 1-12 and 18-25 remain pending in this application.

Priority

The present application serial number 10/765,044 is a continuation of application serial number 08/815,168, which is a continuation-in-part of application serial number 08/598,382, which is a continuation-in-part of application serial number 08/443,607, which is a continuation-in-part of application serial number 08/166,608, which is a continuation of application serial number 07/797,298. On page 2, paragraph 4 *et seq.* of the *Office Action*, the Examiner indicated that the present application discloses and claims only subject matter disclosed in prior application serial number 08/815,168, filed on March 11, 1997, and in application serial number 08/598,382 filed on February 28, 1996. The Examiner further indicated that the elements used in the present application could not be found anywhere in prior application serial numbers 08/443,607 (the '607 application, which issued as U.S. Patent No. 5,724,091); application serial number 08/166,608; and application serial number 07/797,298. The Examiner indicated that the effective filing date of the present application is therefore February 8, 1996 (the filing date of application serial number 08/598,382).

With respect, Applicants assert that both the present application and the older applications to which the present application claims benefit of priority incorporate aspects of interactive program systems. The present application uses many of the same drawings as well as similar accompanying disclosures in the respective specifications to support the currently pending claims.

While the Examiner asserts that elements used in the present application such as audio signal, URL, etc. could not be found anywhere in the prior applications, Applicants respectfully assert that these features are included in the prior applications, either explicitly or incorporated

by reference, as disclosed in the Background and Description of the Preferred Embodiment sections of the prior applications. For example, in col. 4, lines 21- 34, of U.S. Patent No. 5,724,091 (the patent issuing from the '607 application), examples of the audio signal are disclosed. Other features are also disclosed in the patents incorporated by reference and are, additionally, known to a skilled artisan (e.g., audio signals or URLs).

If there are certain claimed features that the Examiner believes are not supported by the disclosures of these earlier applications, Applicants respectfully request that the Examiner provide additional details with regard to these features and the reason for the Examiner's determination that the features are not supported in the earlier applications. Alternatively, Applicants respectfully request that the Examiner reconsider the features and limitations of the pending claims and reconsider the priority date of the present application.

Rejection of the Claims under 35 U.S.C. §112

On page 3, paragraph 5 of the *Office Action*, the Examiner rejected claim 7 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated the claim lacks antecedent basis for the recited viewer profile. The examiner interprets the viewer profile to be the stored set of answers as recited in claim 5.

In response, Applicants have amended claim 7 to recite, *inter alia*, “the selection of the graphics signal a function of the branching codes and the stored set of answers.” Antecedent basis for the “stored set of answers” is found directly in claim 5, from which claim 7 depends. Therefore, since there is no longer an antecedent basis issue due to the amendment, Applicants request the Examiner to reconsider and remove the rejection of claim 7 under 35 U.S.C. §112.

Further on page 3, paragraph 5 of the *Office Action*, the Examiner rejected claim 25, previously depending from claim 23, under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated the claim lacks antecedent basis for the

recited user preferences and has interpreted claim 25 to be dependent from claim 24 that alludes to the user preferences.

In response, Applicants have amended claim 25 to depend from claim 24, thus eliminating the antecedent basis issue. Therefore, since there is no longer an antecedent basis issue due to the amendment, Applicants request the Examiner to reconsider and remove the rejection of claim 25 under 35 U.S.C. §112.

Rejection of the Claims under 35 U.S.C. §102(e)

On page 4, paragraph 7 of the *Office Action*, the Examiner rejected claims 1-7 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,585,858 to Harper et al. (*Harper*). Since a *prima facie* case of anticipation has not been properly established, Applicants respectfully traverse the rejection.

In order to anticipate a claim, a reference must teach all limitations, arranged or combined in the same way as recited in Applicants' claim. The Court of Appeals for the Federal Circuit recently held

[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also ***all of the limitations arranged or combined in the same way as recited in the claim***, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.¹

Because *Harper* fails to disclose all limitations of independent claims 1, 5, and 8, these claims are not anticipated, and are thus novel.²

In particular, Applicants' independent claim 1 recites, *inter alia*,

[A] viewer television reception system to receive interactive programming, ***the interactive programming comprising a plurality of digitally compressed video***, audio, branching codes and graphics signals, the reception system comprising:

¹ *Net MoneyIn, Inc. v. Verisign, Inc.*, No. 2007-1565 at 17. (Fed. Cir. Oct. 20, 2008); emphasis added.

² Claim 8 was not rejected under 35 U.S.C. §102. However, Applicants list a portion of the limitations of claim 8 for comparison with Applicants' other independent claims for further discussion, below.

a first input to receive *interactive programming comprising a stream of said plurality of digitally compressed video*, audio, branching codes and graphics signals

...

a microprocessor, responsive to the viewer interface, to select at least one of the video, audio, or graphics signals from said first input and direct a switch to the selected at least one video, audio, or graphics signals, the selection of the selected at least one video, audio, or graphics signals a function of the branching codes and the input from the viewer;

a decompressor/decoder, to decompress the selected at least one video, audio, or graphics signals; and

an encoder to output the selected at least one video, audio, or graphics signal.³

Each of Applicants' other independent claims, namely claims 5 and 8, share with claim 1 at least limitations similar to these.⁴

In contrast to Applicants' independent claims, *Harper* discusses a simulcast of signals that uses a single standard video and audio television signal with a plurality of additional audio signals or graphics data for providing interactivity.

[T]he interactive television programming used herein preferably comprises *a single standard video and audio television signal with a plurality of additional audio signals and/or graphics data for providing interactivity. The interaction with the subscribers comes primarily by way of selection of one or more linked audio segments from a plurality of audio segments*, whereby the selected audio segment(s) are chosen as a function of previous user responses. *Interactivity is enhanced through the use of overlaid graphics displays on the video which like the audio responses, also vary according to selections made by the subscriber* on the remote device 604.⁵

³ Emphasis added.

⁴ Although not discussed with reference to the 35 U.S.C. §102 rejection, independent claim 8 recites an "output circuit to output the selected at least one video, audio, or graphics signals" rather than an encoder or decompressor/decoder.

⁵ *Harper* at col. 5, lines 42-53; emphasis added.

Consequently, *Harper*, in contrast to Applicants' claimed elements, has no plurality of digitally compressed video signals as recited by Applicants' independent claims. The interactions with subscribers, as discussed in *Harper*, comes by way of selection of one or more linked audio segments from a plurality of audio segments where the selected audio segments are chosen as a function of previous user responses.⁶ *Harper* further discusses "an operations center 608 where the composite interactive program is broadcast, ***the composite interactive program comprising a single video signal, a plurality of audio channels, graphics and control codes.***"⁷

The Examiner cited to *Harper* at col. 4, lines 17-35 to support the anticipation argument with reference to a plurality of compressed video signals.⁸ However, *Harper* refers to a single video signal.

It is an object of the invention to use an analog transmission means for sending multiple interactive audio signals and data codes ***with a single video signal.***

It is an object of the invention to use digital transmission technology for combining multiple interactive audio signals, ***a video signal*** and data codes onto a single composite digital interactive video signal.

...

It is an object of the current invention to provide a dual function program; ***a program that is conventional and can be viewed on conventional television receiving equipment*** and also, allow for this same program to be received interactively once subscribers have the interactive program box.⁹

Thus, *Harper* only contemplates a single video signal, rather than a selection being made from a plurality of digitally compressed video signals. Indeed, the fact that the system of *Harper* envisions "a conventional television" being employed also eliminates the possibility of plurality of digitally compressed video signals or a microprocessor, responsive to the viewer interface, to select at least one of the video being employed.

⁶ See *Harper* at col. 5, lines 46-50.

⁷ *Id.* at col. 6, lines 32-35; emphasis added.

⁸ *Office Action* at 4.

⁹ *Harper* at col. 4, lines 17-35; emphasis added.

Moreover, since there is no plurality of digitally compressed video signals, there can be no microprocessor to select at least one of the video signals or a decompressor/decoder, to decompress the selected at least one video. *Harper* fails to discuss these limitations as well as recited in each of Applicants' independent claims.

Since Applicants have shown that not all the claimed elements were known as required by the *Net MoneyIn* court, Applicants respectfully request the Examiner to reconsider and withdraw the rejection under 35 U.S.C. §102(e) with regard to independent claims 1 and 5. Further, since claims 2-4 and 6-7 depend directly from claims 1 and 5, respectively, they too are allowable for at least the same reasons as the independent claims from which they depend. Further these dependent claims each may contain additional patentable subject matter.

Rejection of the Claims under 35 U.S.C. §102(a)

On page 8, paragraph 8 of the *Office Action*, the Examiner additionally rejected claims 1-7 under 35 U.S.C. §102(a) as being anticipated by International Publication No. WO 95/28804 to Harper et al. (*Harper II*). Since a *prima facie* case of anticipation has not been properly established, Applicants respectfully traverse the rejection.

As discussed above with reference to *Harper*, *Harper II* also fails to disclose all limitations of Applicants' independent claims. Thus, these claims are not anticipated, and are thus novel.

For example, the Examiner cited to *Harper II* at 9 as anticipating Applicants' claim 1 element of interactive programming comprising a plurality of digitally compressed video, audio, branching codes and graphics signals.¹⁰ However, as with *Harper* as noted above, *Harper II* fails to disclose the cited elements of, at least, a plurality of digitally compressed video signals. Instead, *Harper II* merely discusses a plurality of audio signals.

Stacking is a process wherein ***audio feedback response options*** are expanded beyond the available number of channels available by

¹⁰ *Office Action* at 8.

linking a combination of individual audio segments separated 20 in time in an appropriate fashion. For example, *six possible audio responses can be provided with only four channels*.¹¹

Further, *Harper II* discusses that only a single video signal is output, the single audio signal being manually selectable by an instructor to output a graphics signal from the instructor's computer, or a VCR or CD prerecorded video.

The graphics video is output from the Instructor's personal computer to a video mixer. Additional inputs to the video mixer may include the video of the instructor and VCR or CD prerecorded video. The video mixer *outputs a single video signal*. The plurality of audio signals is combined with *the single video signal* along with Interactive data codes in an inserter *to form a single NTSC compatible video signal*.¹²

Since *Harper II* only considers a single video signal, *Harper II* cannot and does not anticipate a plurality of digitally compressed video signals. Since *Harper II* does not anticipate a plurality of digitally compressed video signals, then *a fortiori*, *Harper II* cannot anticipate a microprocessor to select one of the video signals, a decompressor/decoder to decompress the selected video signal, or an encoder to output the selected video.

Since Applicants have shown that not all the claimed elements were known as required by the *Net MoneyIn* court, Applicants respectfully request the Examiner to reconsider and withdraw the rejection under 35 U.S.C. § 102(a) with regard to independent claims 1 and 5. Further, since claims 2-4 and 6-7 depend directly from claims 1 and 5, respectively, they too are allowable for at least the same reasons as the independent claims from which they depend. Further these dependent claims each may contain additional patentable subject matter.

Rejection of the Claims under 35 U.S.C. § 103(a)

On page 11, paragraph 10 of the *Office Action*, the Examiner rejected claims 1-7 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,068,733 to *Bennett* in view of

¹¹ *Harper II* at 9, lines 17-21; emphasis added.

¹² *Id.* at 9, line 30 to 10, line 1; emphasis added.

Harper. Since a *prima facie* case of obviousness has not been properly established, Applicants respectfully traverse the rejection.

The U.S. Supreme Court decision of *KSR v. Teleflex* provides a tripartite test to evaluate obviousness.

The rationale to support a conclusion that a claim would have been obvious is that *all the claimed elements were known in the prior art* and one skilled in the art could have combined the elements as claimed by known methods *with no change in their respective functions*, and *the combination would have yielded nothing more than predictable results* to one of ordinary skill in the art.¹³

Applicantss will show that the cited references, either singly or in combination, neither teach nor suggest all limitations of Applicants' claimed elements, with no change in the respective functions of the cited references, nor is there any substantiating evidence that the combination of the references would have yielded nothing more than predictable results. "If *any of these [three] findings* cannot be made, then this rationale [of combining prior art elements according to known methods to yield predictable results] cannot be used to support a conclusion that the claim would have been obvious."¹⁴

Although other rationales for rejection under 35 U.S.C. §103(a) may exist, the basis for an obviousness rejection is still grounded in a consideration of all claim elements. "All words in a claim must be considered in judging the patentability of that claim against the prior art."¹⁵ Additionally, to render the claimed subject matter obvious, the prior art references must teach or suggest every feature of the claims.¹⁶

In contrast to Applicants' claims, *Bennett* discloses transmitting multiple related analog video signals collected from video camera sources (11, 13, 15, 17) at a remote studio (1) by

¹³ See *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007); see also MPEP § 2143, emphasis added.

¹⁴ MPEP § 2143, emphasis added.

¹⁵ *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See also MPEP § 2143.03.

¹⁶ See Manual of Patent Examining Procedure §§ 706.02(j), 2143(A) (2008); MPEP § 2142 (2006) (citing *In re Vaeck*, 947 F.2d, 488 (Fed. Cir. 1991). Cited approvingly in *Ex parte WEN WEN* and *PATRICIA NG* at 7; Appeal No. 2009-000776; decided September 25, 2009.

microwave transmission (75, 77, 79, 81, 83) to a combiner (85).¹⁷ Once combined, the video signals are transmitted via radio frequency broadcast (87) to a cable transmission system head end (133) where the video signals are demodulated from the radio frequency broadcast and split apart into separate microwave transmissions for input to the cable distribution system (133).¹⁸ There is no further teaching in *Bennett* regarding how the video signals are ultimately formatted and distributed by the cable head end.¹⁹ *Bennett* only describes the collection of video signals and a methodology for providing those signals to a cable head end. With regard to reception and presentation to a user, *Bennett* merely states that each camera is “associated with ***a different channel on a conventional receiver*** . . . [To select a particular camera,] the viewer simply chooses the appropriate channel on the receiver.”²⁰

However, there is no teaching within *Bennett* of how to transmit multiple related video signals to a receiver for access and viewing by a user. In this respect, *Bennett* is not even analogous as a reference since there is no teaching or suggestion of Applicants’ claimed elements of an interactive program comprising a plurality of digitally compressed video signals or a first input to receive interactive programming comprising a stream of said plurality of digitally compressed video.

Moreover, the Examiner relies exclusively on *Harper* to teach or suggest Applicants’ claimed elements of certain limitations of Applicants’ claims.

Bennett does not explicitly teach of branching codes, digital video/audio, and graphics signals which are digitally compressed, decompressor/decoder, connected to the demultiplexer for decompressing the demultiplexed selected at least one video, audio, or graphics signals; and said user input from said viewer requested as an interrogatory when an interactive program begins or when said viewer first tunes in said interactive program.²¹

The Examiner further relied on *Harper* alone to provide certain of Applicants’ claimed elements.

¹⁷ See *Bennett* at Figs. 1A and 1B and the accompanying description.

¹⁸ *Ibid.*

¹⁹ See, e.g., *Bennett* at col. 2, lines 17-40.

²⁰ *Id.* at col. 1, line 67 to col. 2, line 2; emphasis added.

²¹ *Office Action* at 12; emphasis added.

[T]he selection of the video and audio signals and the predetermined time of each selection a function of the branching codes and the received viewer entries (col. 8 lines 15-33); and said user input from said viewer requested as an interrogatory when an interactive program begins or when said viewer first tunes in said interactive program (See Harper, col. 6 lines 1-7 which discloses the interrogatory being presented at the onset of the program for viewer response).²²

However, as discussed above, *Harper* only contemplates a single video signal, rather than a selection being made from a plurality of digitally compressed video signals. Indeed, the fact that the system of *Harper* envisions “a conventional television” being employed also eliminates the possibility of plurality of digitally compressed video signals or a microprocessor, responsive to the viewer interface, to select at least one of the video being employed.

Moreover, since there is no plurality of digitally compressed video signals, there can be no microprocessor to select at least one of the video signals or a decompressor/decoder, to decompress the selected at least one video. *Harper* fails to teach or suggest these limitations as well as recited in each of Applicants’ independent claims.

Applicants respectfully remind the Examiner that, in determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is *not whether the differences themselves* would have been obvious, but *whether the claimed invention as a whole would have been obvious*.²³ Since Applicants have shown that not all the claimed elements were known as required by *KSR*, either by *Bennett* singly or in combination with *Harper*, Applicants respectfully request the Examiner to reconsider and withdraw the rejection under 35 U.S.C. §103 with regard to independent claims 1 and 5. Further, since claims 2-4 and 6-7 depend directly from claims 1 and 5, respectively, they too are allowable for at least the same reasons as the independent claims from which they depend. Further these dependent claims each may contain additional patentable subject matter.

²² *Ibid.*; emphasis added.

²³ *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

On page 15, paragraph 11 of the *Office Action*, the Examiner rejected claims 8-12 and 18-25 under 35 U.S.C. §103(a) as being unpatentable over *Bennett* in view of *Harper*, and further in view of U.S. Patent No. 5,761,606 to *Wolzien*. However, as discussed above, claim 8 shares many of the above-discussed limitations with independent claims 1 and 5 that have already shown to be patentable in light of any combination of *Bennett* and *Harper*. The Examiner relies upon *Wolzien* solely “for providing programming comprising of internet addresses.”²⁴ Thus, *Wolzien* fails to cure any of the deficiencies discussed above with reference to either *Bennett* or *Harper*. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw the rejection under 35 U.S.C. §103 with regard to independent claim 8 for at least the same reasons as discussed above with reference to independent claims 1 and 5. Further, since claims 9-12 and 18-25 depend directly from claim 8, they too are allowable for at least the same reasons as the independent claim from which they depend. Further these dependent claims each may contain additional patentable subject matter.

On page 20, paragraph 12 of the *Office Action*, the Examiner rejected claims 8-12 and 18-23 under 35 U.S.C. §103(a) as being unpatentable over *Harper II* in view of *Wolzien*. However, as discussed above, claim 8 shares many of the above-discussed limitations with independent claims 1 and 5 that have already shown to be patentable in light of *Harper II*. The Examiner relies upon *Wolzien* solely “for providing programming comprising of internet addresses.”²⁵ Thus, *Wolzien* fails to cure any of the deficiencies discussed above with reference to *Harper II*. Thus, Applicants respectfully request the Examiner to reconsider and withdraw the rejection under 35 U.S.C. §103 with regard to independent claim 8 for at least the same reasons as discussed above with reference to independent claims 1 and 5. Further, since claims 9-12 and 18-25 depend directly from claim 8, they too are allowable for at least the same reasons as the independent claim from which they depend. Further these dependent claims each may contain additional patentable subject matter.

On page 22, paragraph 12 of the *Office Action*, the Examiner rejected claims 24-25 under 35 U.S.C. §103(a) as being unpatentable over *Harper II* in view of *Wolzien* and further in view

²⁴ *Office Action* at 17.

²⁵ *Id.* at 20.

of U.S. Patent No. 5,706,493 to *Sheppard*. However, since claims 24-25 depend directly from claim 8, they too are allowable for at least the same reasons as the independent claim from which they depend. Further these dependent claims each may contain additional patentable subject matter.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned attorney at (408) 660-2015 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402--0938
(408) 660-2015

Date February 12, 2010

By



Bradley W. Scheer
Reg. No. 47,059

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 12 day of February, 2009.

John D. Gustav-Wrathall

Name

Signature

